

ANCOROTTI, R.  
Appl. No. 10/500,332

### **REMARKS/ARGUMENTS**

Reconsideration and withdrawal of the Rejections of the Office Action and allowance of the claims are respectfully requested in view of Applicants' remarks below.

#### **Remarks Regarding Amendments**

Claims 29 and 43 are amended to remove the term "non-pressed." Claim 29 is amended to remove the features of "wherein said fatty emulsion and said coloring powders are mixed in a proportion of about 50-50% by weight" and "in an oven at a temperature between 35 and 55°C." Claims 42 is amended to add a limitation to step (b) which now states, inter alia, "wherein said fatty emulsion and said coloring powders are mixed in a proportion of about 50/50% by weight." The claims are also amended to recite that the process produces an eye shadow, a face powder or a blusher. New claims 44-47 are also added specifically to claim these embodiments. These amendments are supported throughout the Specification such as, for example, on page 1 lines 3-4 of the Specification as filed. Entry of the amendments is respectfully requested.

#### **Remarks Regarding 35 U.S.C. 112, first paragraph**

Claims 18, 29, 42 and 43 stand rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement. Applicants traverse.

Specifically, the Examiner submits that support for the limitation "non-pressed powder" as filed on July 6, 2007 and January 10, 2008 is lacking in written description support and should be considered new matter.

Applicants note that the limitation of "non-pressed powder" was introduced following a telephone interview with the Examiner on June 28, 2007. The substance of that interview was listed in (1) Applicants' July 16, 2007 "Statement of Substance of Interview Under MPEP §713.04" which was entered into record without dispute from the Examiner, (2) the Examiner's

ANCOROTTI, R.  
Appl. No. 10/500,332

Interview Summary of July 12, 2007. The Examiner approved of this limitation by entering it into the claims following Applicants' amendment.

Furthermore, support for this limitation may be found throughout the Specification and which was presented to the Examiner in the June 28, 2007 interview. Additional support for this limitation may be found on page 1, lines 19-21 and on page 7 line 18. This support was submitted to the Examiner in Applicants' papers submitted on July 6, 2007 and January 10, 2008 and accepted by the Examiner by the entry of the Amendments.

The Examiner further asserts that Applicants stated, on page 7, lines 19-22 that Applicants state in the disclosure that the products of the invention is an alternative to non-pressed powders. Applicants respectfully disagree because Applicants' disclosure is taken out of context and is interpreted in a manner contrary to the language of 35 U.S.C. 112.

35 U.S.C. 112 states, inter alia, "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention" (emphasis added). Under this spirit, Applicants have written the Specification in concise language following conventional English usage.

Page 7, lines 19-22 of Applicants' Specification is reproduced exactly as filed below:

**The products obtained by means of the process of the invention therefore represent a valid alternative to the conventional products such as in pressed or non-pressed powders and creamy type products.**

This section of Applicants' Specification must be read in the context of conventional English usage. The first part of the sentence states that the products obtained by means of the process of the invention therefore represent a valid alternative to the conventional products . . . Examples of conventional products are thereafter listed. Any person skilled in the art would understand

ANCOROTTI, R.  
Appl. No. 10/500,332

that each of these listed products is a conventional product. Similarly, any person skilled in the art would understand that "pressed" is not a product and "pressed" refers to "conventional pressed powder product." Further, any person skilled in the art would understand that "non-pressed powder" is "non-pressed powder product."

Therefore, taken in context and in the spirit of 35 U.S.C. 112, the above quoted sentence has the following meaning:

The products obtained by means of the process of the invention therefore represent a valid alternative to the conventional products such as [conventional] pressed [powder products], [conventional] non-pressed powder [products] and [conventional] creamy type products.

For the reasons stated above, Applicants respectfully assert that the Specification has not excluded non-pressed powder from the claimed invention.

The examiner also asserts that non-pressed powders are loose (see, Office Action, page 3 line 20) and cannot be shaped or sized. The Office Action has taken the position that since non-pressed powders are loose it cannot be extruded, shaped and cannot have a hardness that can be measured. Applicants strongly disagree.

As it is clearly stated in the Specification and the claims (see, e.g., claim 1), one aspect of the invention can be a process involving, inter alia, mixing a powder with an emulsion which can be a wax and drying at a temperature such as 55°C. Therefore, the non-pressed powder is bound together by an emulsion such as a wax without any sort of pressing. One of skill in the art would recognize that when a powder is mixed with wax and dried at 55°C without any pressing, it can form a shape with a hardness.

For all of the above reasons, Applicants respectfully assert that the Specification and claims as filed and the pending claims do not exclude non-pressed powder and in fact describes many types of non-pressed powders.

ANCOROTTI, R.  
Appl. No. 10/500,332

Solely in an effort to expedite prosecution, Applicants have amended claims 29 and 43 to remove the phrase “non-pressed.” Applicants also note that claims 29 and 43 use “consists” when referring to the process and the claimed process does not contain a pressing step. Therefore, claims 29 and 43 and claims dependent thereon still relates to a process to produce a non-pressed product since a pressing step is excluded by the “consists” language. Since the phrase alleged to lack written descriptive support has been removed, the rejection is moot at least with respect to claims 29 and 43.

The withdrawal of this rejection is respectfully requested.

Remarks Regarding 35 U.S.C. 103

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *In re Kahn*, 78 USPQ2d 1329, 1334 (Fed. Cir. 2006) citing *Graham v. John Deere*, 148 USPQ 459 (1966). The *Graham* analysis needs to be made explicitly. *KSR v. Teleflex*, 82 USPQ2d 1385, 1396 (2007). It requires findings of fact and a rational basis for combining the prior art disclosures to produce the claimed invention. See *Id.* (“Often, it will be necessary for a court to look to interrelated teachings of multiple patents . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue”). The use of hindsight reasoning is impermissible. See *Id.* at 1397 (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning”). Thus, a prima facie case under Section 103(a) requires “some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct.” *Kahn* at 1335; see *KSR* at 1396.

Claims 18, 19, 21, 24, 25, 27-30, 32, 35, 36, 38-40, 42 and 43 stand rejected under 35 U.S.C. 103 as allegedly obvious in view of a combination of *Le Bras et al.* (U.S. Patent 5,858,381) and *Verdon et al.* (U.S. Patent 4,994,264). Applicants traverse.

ANCOROTTI, R.  
Appl. No. 10/500,332

The claims are not obvious in view of Le Bras and Verdon at least because the claims are now limited to processes to produce eye shadow, face powders or blushers. La Bras does not disclose or render obvious an eye shadow, face powder, or blusher but is related to a curative, healing or disinfective products. See, e.g., the three examples of La Bras.

In fact, the molded piece of La Bras have a high mechanical strength (See, La Bras, column 2, line 65) that is absolutely incompatible with eye shadows, face powders or blushers. This is evident also from the fact that it can be cemented in wood to form sharpenable sticks or pencils and can be introduced in sleeves. See, La Bras, column 8, last paragraph and column 9 first paragraph).

In addition, La Bras does not disclose or render obvious the preparation of a “fatty emulsion phase” and “coloring powder phase” that are subsequently mixed together either. In La Bras, the paste is compressed in the process and which does not occur in the claimed invention.

As it is clearly evident in the pending claims, the claims relate to pastes that is extruded to obtain an extruded product and said extruded product is then dried.

For the reasons stated above, the claims are not obvious in view of La Bras. The addition of Verdon does not cure the defects of La Bras.

Verdon is as defective as La Bras because Verdon does not disclose or render obvious the preparation of a fatty emulsion phase, but it only shows a slurry prepared from gum and water. Because of this, it does not describe the preparation of a “fatty emulsion phase” and “coloring powder phase” that are then mixed together.

Furthermore, in the method of Verdon, the paste is formed and then extruded. The past exiting the extruder goes directly into a standard cosmetic compression molding device (see, Verdon, column 4, lines 28-31). In fact, in the cited passage, it is clearly stated that “the paste is extruded . . . in a standard cosmetic compression molding device. This is in direct contradiction of Applicants’ claims which do not involve compression or molding.

According to Verdon, the paste is:

ANCOROTTI, R.  
Appl. No. 10/500,332

- extruded,
- compressed (in a standard compression molding device) and then
- dried.

In contrast, the claimed processes disclose a process that produces an extruded product that is dried after the extrusion process. The claimed processes do not involve a pressing or compressing step after extrusion or at all.

For at least the above stated reasons, the claimed process is not obvious in view of the cited references.

In addition, claims 18 and 42 are further non-obvious in view of the cited references for the following reason. Claims 18 and 42 and claims dependent thereon (i.e., claims 19, 21, 24, 25, and 27-28) are directed to, inter alia, processes involving a step as follows:

- (b) mixing said fatty emulsion and said coloring powders to obtain a paste wherein said fatty emulsion and said coloring powders are mixed in a proportion of about 50/50% by weight;

This limitation is in the independent claims 18 and 43. The dependent claims (i.e., claims 19, 21, 24, 25, and 27-28) incorporate the recitations of one of the independent claims by nature of their dependency. Therefore, the above quoted limitation is in every pending claim. The pending claims are not obvious in view of a combination of the cited references at least because the combination does not disclose this limitation.

The Office Action alleged that Le Bras teaches “wherein said fatty emulsion and said coloring powders are mixed in a proportion of about 50/50% by weight” in column 11 lines 30-43. See, Office Action, paragraph spanning pages 5 and 6. Applicants disagree. Column 11 lines 30-43 of La Bras is reproduced below:

ANCOROTTI, R.  
Appl. No. 10/500,332

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Yellow iron oxide	1.04
Red-yellow iron oxide	0.52
Black iron oxide	0.14
Titanium dioxide	6.3
Tricethanolamine	0.69
Stearic acid	1.38
Glyceryl stearate	1.38
Stabilizer	0.1
Isoparaffin	4.41
Expanded microspheres sold by the "Kemanord Plast" company under the trade name "Expancel"	0.59
Silica microspheres sold by the "Miyoshi" company under the trade name "Silicaheads SB 700"	44.41
Talc	5
Water q.s.	100

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According to Applicants claims, the mixture of coloring powders includes matte or pearly pigments, synthetic pigments, natural pigments or both synthetic and natural pigments, with inert powders as diluents. See, e.g., all the independent claims which are claims 18, 29, 42 and 43. Suitable coloring powder is defined in Applicants' Specification on page 3 lines 13-17 as:

Suitable colouring powders are, for example, those obtained by mixing synthetic and/or natural pigments, matte or pearly, with inert  
15 powders as diluents such as mica or talc, in varying quantities according to the powdery effect and colouring power required.

It is also defined in Applicants' Specification on page 6 lines 18-22 as:

The colouring powders are generally prepared by mixing the required pigments with inert components such as talc, silica and mica.  
20 According to a preferred embodiment, parabenes and sodium dehydroacetate are added to the mixture to preserve the entire product during all the processing phases.

Therefore it is clear from the claims and the definition of the Specification that coloring powder includes inert powders which include talc and silica.

In view of the above, the amount of coloring powder disclosed by column 11 lines 30-43 of La Bras (reproduced above) include:

yellow iron oxide                      1.04 parts out of 100 parts

ANCOROTTI, R.  
Appl. No. 10/500,332

red-yellow iron oxide	0.52 parts out of 100 parts
black iron oxide	0.14 parts out of 100 parts
titanium dioxide	6.30 parts out of 100 parts
silica	44.41 parts out of 100 parts
talc	5.00 parts out of 100 parts

which adds up to a total of 57.11 which is over half of the total weight of 100 parts. According to the examiner, La Bras also shows the use of 7.17 parts out of 100 parts of a fatty phase. A 57.11 part of coloring powder vs. 7.17 parts of a fatty phase which is alleged to be a fatty emulsion cannot be said to be even closed to the claimed ratio of 50/50%. For at least this reason, the claimed invention is not obvious in view of La Bras.

The addition of Verdon does not cure the defects of La Bras. Verdon, like La Bras is silent as to the claimed step of “mixing said fatty emulsion and said coloring powders to obtain a paste wherein said fatty emulsion and said coloring powders are mixed in a proportion of about 50/50% by weight.”

For the reasons stated above, a combination of the cited references fails to disclose the claimed step of

(b) mixing said fatty emulsion and said coloring powders to obtain a paste wherein said fatty emulsion and said coloring powders are mixed in a proportion of about 50/50% by weight;

which is in every independent pending claim. Since the combination fails to disclose or render obvious a claimed step, an obviousness rejection is improper with respect to claims 18 and 42 and claims dependent thereon (i.e., claims 19, 21, 24, 25, and 27-28).

Withdrawal of the Section 103 rejections is requested because the claims would not have been obvious to one of ordinary skill in the art when this invention was made.




ANCOROTTI, R.  
Appl. No. 10/500,332

CONCLUSION

Having fully responded to the pending Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if additional information is required.

Respectfully submitted,

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